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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/578,119
Filing Date: May 01, 2006
Appellant(s): CHASSAGNON ET AL.

Thomas Langer
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed March 24, 2011 appealing from the Office action mailed March 16, 2010.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 1, 4-10, 13, 14, 20 and 21 are pending and rejected.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

US 2002/0198305	Hopkins	12-2002
US 2004/0127617	Vasseur	7-2004
WO 02/088238	Vasseur	11-2002
US 2004/0030017	Simonot	2-2004

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 4-10, 13, 14, 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hopkins (US 2002/0198305) in view of Vasseur et al. (WO 02/088238) and Simonot et al. (US 2004/0030017). For convenience, the citations below for Vasseur et al. are from English language equivalent (US 2004/0127617).

Hopkins teaches vehicle tires with treads made from a rubber composition (¶84) comprising a mixture of natural rubber and brominated butyl rubber (¶3, 13), silica (¶20), and a coupling agent (¶8). The butyl rubber may be present in from 30 to 75 phr with the natural rubber making up the remainder of the elastomer component in an amount to give 100 phr of the elastomer component (Table 1, examples 4-6) and the silica is present most preferably in 40 to 80 phr (¶78).

Hopkins et al. does not teach that the composition contains from 15 to 30 phr of glycerol trioleate, which has an oleic acid content of more than 80% by weight, or sunflower oil having an oleic acid content of more than 80% by weight. However, Vasseur et al. teaches a rubber composition for a tire tread that contains from 10 to 40 phr of a plasticizer that is glycerol trioleate (having an oleic acid mass fraction equal to or greater than 85%) or a high oleic acid sunflower oil (having an oleic acid mass fraction equal to or greater than 85%) (¶64-71). Hopkins and Vasseur et al. are analogous art because they are from the same field of endeavor, namely that of rubber compositions for tire treads. At the time of the invention, a person of

ordinary skill in the art would have found it obvious to use a plasticizer, as taught by Vasseur et al., in the composition, as taught by Hopkins, and would have been motivated to do so because Vasseur et al. suggests the grip performance of the tire tread is conserved over time when this type of plasticizing agent is used in the rubber composition of the tire tread (¶40).

Hopkins does not teach that the diene elastomer component of the composition further comprises a styrene butadiene rubber prepared in a solution and a polybutadiene rubber. However, Simonot et al. teaches rubber composition for tire treads (Abstract) that contain diene rubbers. Simonot et al. lists many examples of diene rubbers as satisfactory choices, such as natural rubber (¶80), for the composition. Moreover, for a passenger car, Simonot et al. teaches that the diene rubber is preferably a styrene butadiene rubber (solution prepared)/butadiene rubber blend (¶82). Hopkins and Simonot et al. are analogous art because they are from the same field of endeavor, namely that of diene rubber compositions for tire treads. At the time of the invention, a person of ordinary skill in the art would have found it obvious to substitute the styrene butadiene rubber/butadiene rubber blend, as taught by Simonot et al., for the natural rubber component of Hopkins, and would have been motivated to do so because the prior art recognizes them as being equivalents known for the same purpose and, moreover, the blend of Simonot et al. is more preferable for passenger car tires, which the instant claim desires.

The Office would like to note that the limitation of claim 20 regarding the solution polymerization of styrene butadiene rubber is a product-by-process limitation. It has been taught by Simonot et al. However, for future reference, even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

(10) Response to Argument

I. Applicant argues that Hopkins does not teach a tire tread composition for a passenger car. Therefore, a modification of Hopkins based on Vasseur and Simonot as proposed by the Examiner would not produce the invention of claim 1 and its dependent claims, which are directed to a passenger car tire.

While it is true that Hopkins does not explicitly teach a tire tread for a passenger car as an end use of its composition, the claim limitation of a passenger car is an intended end use of the tread claimed. If the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction. *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999). If a prior art structure is capable of performing the intended use as recited in the preamble, then it meets the claim. See, e.g., In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). MPEP 2111.02. In this case, Hopkins teaches a tire tread comprising a diene rubber, silica, a coupling agent and a lubricant (plasticizing agent). Hopkins teaches the main components of the tire tread composition and teaches that it is useful for vehicles, especially trucks and buses. However, this composition is capable of being used a tire tread for a passenger car since passenger cars use the same roads as trucks and buses. Therefore, since the tire tread is capable of use as a tread for a passenger car, the claim limitation is met.

Furthermore, appellant spends time arguing the differences between truck and bus tires as opposed to passenger car tires. While a tire *as a whole* may have differences, e.g., interior structure or sidewall construction, when formed for a truck or bus as opposed to a car, this case is concerned with the tread composition. The tread composition as described by Hopkins is capable of use as a tread for a passenger car and this is the test the MPEP says is applied in this instance.

II. Applicant argues that there is no apparent reason for a person of ordinary skill in the art to modify the tire treads of Hopkins, which are designed for trucks, based on the relevant teachings of Vasseur and Simonot, which are all directed to tire treads for passenger cars.

The teaching in Vasseur is used to modify the teaching of Hopkins by adding to the composition of Hopkins the particular plasticizing agent claimed. Appellant argues that one of ordinary skill in the art would not make this modification because Vasseur is directed toward light, passenger car tires and Hopkins is directed toward heavy, truck tires. As discussed above,

the tire treads as taught by Hopkins are capable of use as treads for passenger car tires. Therefore, this argument is not persuasive. Moreover, Hopkins teaches that a processing oil and a lubricant can be added to the composition. Plasticizers help to soften the composition as to processing oils and lubricants (¶78). Since Hopkins already teaches the inclusion of processing oil and lubricants, one of ordinary skill in the art would have an expectation of success in using the particular plasticizer of Vasseur in the composition of Hopkins.

The teaching in Simonot is used to modify the teaching of Hopkins by adding in a styrene-butadiene rubber and a butadiene rubber. Appellant uses a similar argument here as for Vasseur above in that one of ordinary skill in the art would not make this modification because Simonot is directed toward light, passenger car tires and Hopkins is directed toward heavy, truck tires. Again, as discussed above, the tire treads as taught by Hopkins are capable of use as treads for passenger car tires. Therefore, this argument is not persuasive. Moreover, Hopkins teaches that its composition may be further mixed with other rubbers such as butadiene rubber and styrene-butadiene rubber (¶86). Since Hopkins already teaches the inclusion of styrene-butadiene rubber and butadiene rubber in its composition, one of ordinary skill in the art would have an expectation of success in incorporating the styrene-butadiene and polybutadiene taught by Simonot into Hopkins.

As for the genus/species arguments surrounding the passenger car limitation, the passenger car limitation has been addressed previously as an intended end use of the tire tread composition.

III. Applicant argues that a person of ordinary skill in the art would not substitute the blend of SBR and butadiene rubber used in Simonot's composition for the natural rubber used in Hopkins' composition.

As discussed above, Hopkins teaches that its composition may be further mixed with other rubbers such as butadiene rubber and styrene-butadiene rubber (¶86) and that the tire treads as taught by Hopkins are capable of use as treads for passenger car tires. Therefore, one of ordinary skill in the art would apply the teachings of Simonot to Hopkins. Moreover, the natural rubber of Hopkins would not have to be completely replaced, it may be supplemented by the styrene-butadiene and butadiene.

IV. Applicant argues that a person of ordinary skill in the art would not have a reasonable expectation of success for the modification as proposed by the Office.

This argument is wholly unpersuasive. As discussed in the previous arguments, Hopkins teaches that its composition may contain a process oil or a lubricant, which serves the same purpose as the plasticizing agent, and that it may also contain styrene-butadiene rubber and butadiene rubber. One of ordinary skill in the art would have an expectation of success in adding the specific plasticizing agent of Vasseur and the specific blend of styrene-butadiene rubber and butadiene rubber of Simonot to the composition of Hopkins. These modifications would not adversely effect the composition of Hopkins because Hopkins suggests the inclusion of these compounds. There is a reasonable expectation of success with these modifications.

V. Applicant argues that Hopkins fails to teach the use of 40 to 80 phr of butyl rubber in its composition. Therefore, a modification of Hopkins as proposed by the Office would not arrive at the present invention.

Table 1 of Hopkins teaches compositions comprising 50 and 75 phr of butyl rubber. Therefore, this limitation is taught by Hopkins.

VI. Applicant argues that the unexpected results obtained with the present invention further show that it is patentable in view of the prior art.

Appellant points to the two compositions compared in paragraphs 122-140 of its published application. These two examples are not good side-by-side comparisons as more than one variable is changed between the two compositions, e.g., the amounts and types of rubbers as well as the processing oil/plasticizing agent. Therefore, the results that these compositions produce cannot be properly evaluated as to their unexpectedness. Additionally, claim 1 recites a range for the butyl rubber and a range for the plasticizing agent and only one data point of each is given. These two examples do not constitute a proper showing of unexpected results.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Angela C Scott/

Examiner, Art Unit 1767

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